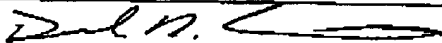


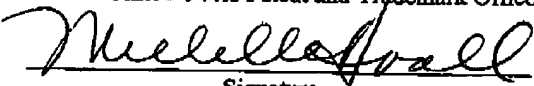
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TRANSMITTAL FORM (to be used for all correspondence after initial filing)		Application Number	09/270,710
		Filing Date	March 16, 1999
		First Named Inventor	Lawrence F. GLASER
		Group Art Unit	3626
		Examiner Name	Alexander G. Kalinowski
Total Number of Pages in This Submission	6	Attorney Docket Number	740388-20

ENCLOSURES (check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> One Month Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers (for an Application) <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Declaration and Power of Attorney <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to Group (REPLY BRIEF) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Application Data Sheet <input type="checkbox"/> Request for Corrected Filing Receipt with Enclosures <input type="checkbox"/> A self-addressed prepaid postcard for acknowledging receipt <input type="checkbox"/> Other Enclosure(s) (please identify below):
Remarks <input checked="" type="checkbox"/> The Commissioner is hereby authorized to charge any additional fees required or credit any overpayments to Deposit Account No. 19-2380 for the above identified docket number.		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	Donald R. Studebaker, Reg. No. 32,815 Nixon Peabody LLP 401 9 th Street, N.W. Suite 900 Washington, D.C. 20004-2128
Signature	
Date	July 31, 2006

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Attorney Docket No. 740388-20

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Patent Application of:) Confirmation No.: 2842
Lawrence F. Glaser)
Application Serial No.: 09/270,710) Examiner: Porter, Rachel L.
Filed: March 16, 1999) Group Art Unit: 3626
For: METHOD OF EMBEDDED) July 31, 2005
ADVERTISEMENT IN)
COMMUNICATION)

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Michelle Duval

REPLY BRIEF

Mail Stop **Appeal Brief- Patents**
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Sir:

This Reply Brief is submitted in response to the Examiner's Answer dated May 31, 2005.

In the Examiner's Answer, there is no new rejection, and the Examiner's arguments are a repeat from previous rejections. In response, Applicant respectfully emphasize the following arguments submitted in the Appeal Brief and request the Appeal Brief be reinstated and impartially reviewed by the Board.

With respect to the obviousness rejection of claim 1 over Goldschmitt and Bezos, the Examiner continues to assert that Bezos teaches the step of embedding an advertisement within a communication or associating at least one pre-selected advertisement with the communication with the data system of the sending party. In response, Appellant respectfully submits that the Examiner failed to consider the teaching of Bezos in its entirety and failed to establish a *prima facie* case of obviousness.

As submitted in the Appeal Brief, Bezos discloses a software system and method for

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enabling an Internet sales merchant, to market and sell goods in cooperation with Web sites or other networks sites of respective business partners, referred to as "associates." The merchant can enroll as an associate, and can disseminate catalogs (web documents, PUSH documents, e-mail newsletters, etc.) that include the associate's reviews and/or recommendations on specific products sold by the merchant. The associate catalog documents referred to by the Examiner is the catalog document 120 (i.e., HTML documents or web pages in Fig. 6) include product-specific hyperlinks (i.e., referral links 600 or 608), and a statement 606 directly related to the product referred to in the referral hyperlink. Appellant respectfully asserts that the disseminated catalogs (i.e., HTML web pages selling products) of Bezos do not have advertisements embedded therein as required by the pending claims, and that the catalog document 120 with referral hyperlink 600 or 608 is unlike Appellant's communication and pre-selected advertisement.

In other words, contrary to the Examiner's understanding, Bezos does not teach the association of advertisements in a communication and transmitting the communicating with the embedded advertisement to a recipient. Instead, as disclosed by Bezos, an "associate" web site provides a hypertextual "referral link" that allows a customer visiting the associate's web site to link to the merchant's web site by clicking on a "referral link" to initiate purchases of products from the merchant, which subsequently allows the merchant to identify the product and its referring associate.

In Bezos, the referral hyperlink (600 or 608) displayed in an HTML catalog document 120, as shown in Fig. 6 of Bezos, is an essential component in a software system and method for enabling an Internet sales merchant (e.g., Amazon.com), to market and sell goods to "customers" in cooperation with Web sites or other network sites of respective business partners, referred to as "associates." The referral hyperlink of Bezos includes a unique product ID, the unique store ID associated with a particular associate, and an optional associate commission ID from the URL data string represented by the referral hyperlink.

Further, the invention of Bezos, as interpreted by the Examiner, requires an interaction between the "customer," the "associate" and the "merchant," and the essential feature which enables the business paradigm to work is the referral hyperlink. That is, without the referral hyperlink or the existence of the "merchant", the system or process of Bezos would not work. In combining Bezos with Goldschmitt, the Examiner essentially

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ignored the criticality of the function of the "merchant" and of the real function of the referral hyperlink of Bezos. In other words, the Examiner failed to consider that the critical "merchant" taught in Bezos has no similar limitation or equivalent function in Appellant's claimed invention or in that of Goldschmitt, and that the Examiner failed to consider the teaching of Bezos in its entirety in establishing a *prima facie* case of obviousness (See MPEP 2141.02 p. 2100-122 Rev. 1, Feb. 2003).

Further, as presented in the Appeal Brief, the Examiner's numerous changing of interpretation of whether the hyperlink of Bezos constitute an embedded advertisement or not has led Appellant to add dependent claims 25 and 26, which respectively depend from independent claims 1 and 20, in the Amendment filed January 10, 2005 and the RCE filed March 10, 2005 to effect their entry. By the addition of dependent claims 25 and 26, Appellant invoked the Doctrine of Claim Differentiation to distinguish the embedded pre-selected advertisement of Appellant's claimed invention from the hyperlink of Bezos. Dependent claims 25 and 26 clearly differentiate from the meaning and scope of independent claims 1 and 20, respectively. In other words, by separating the feature wherein the at least one advertisement includes a hyperlink, Appellant has clearly distinguished a hyperlink from an embedded advertisement. That is, in Appellant's claimed invention, referral hyperlinks are not themselves an advertisement, which is inherently different from the Examiner's interpretation of the referral hyperlink of Bezos. Appellant respectfully asserts that there is no distinction between a hyperlink and an advertisement disclosed or suggested by Bezos, and the Examiner's interpretation that anything under the sun can be an advertisement is overly broad.

With respect to the rejection of claim 20, as previously submitted in the Appeal Brief, the combination of Uomini with Goldschmitt and Bezos is improper. The Examiner asserted that the vCard being attached to an e-mail message as disclosed in Uomini encompasses Appellant's claimed step of modifying the information stored within the signature file to include an advertisement. However, Appellant disagree for at least three reasons: First, Goldschmitt specifically teaches that advertisement attached to an electronic mail is done without interfering with the integrity of the message data contained with the electronic mail. Therefore, it would be contrary to the teaching of the primary reference to Goldschmitt to modify the information stored within the signature file to include at least one advertisement,

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as recited in Appellant's claim 20. Second, as Uomini teaches a system for adding to electronic mail message context information which assists the receiver of electronic mail messages in identifying sender and/or where the electronic mail has originated, Uomini does not suggest or motivate modifying the information stored in the signature file to include an advertisement as recited in claim 20. Third, the vCard of Uomini is not a signature file, and the vCard cannot be and are not to be inserted or embedded into an e-mail signature file because there is no such teaching, disclosure or suggestion in Uomini.


With respect to the rejection of independent claim 24, Appellant respectfully submits that Goldschmitt does not teach, disclose or suggest at least the feature wherein the pre-selected advertisement is under the control of the sending party as asserted by the Examiner. As submitted in the Appeal Brief, the center 20 and email server 18 of Goldschmitt are not managed by or under the local control of the user or email sender. That is, the sending party does not have control or management of Goldschmitt center 20 and email server 18 to perform the steps recited in Appellant's pending claim 24. As disclosed in Fig. 1, page 8, line 26 - page 9, line 2, Goldschmitt teaches that a message sent by user 12 to user 20 and is stored at center 18 until user 20 accesses it. When user 20 commands to read the message, the center 18 then appends an advertisement, if any, to the message and transmits the message to user 20.

Further, in the invention of Goldschmitt, subscribers of free e-mail in the invention of Goldschmitt are provided with no choice but to have email advertisement appended to their messages, and the subscribers of free email messaging have no control over the products, or services that are advertised by the sponsors. Hence, the free e-mail service of Goldschmitt with the condition that subscribers have to view advertisements indiscriminately is undesirable compared to Appellant's claimed invention that provides a telecommunication message with an advertisement in a point-to-point advertisement method which is highly personal because the sender has control over advertisements and their recipients. That is, in the presently claimed invention, the sender has control of the advertisement to be sent with a communication, while in Goldschmitt there is no such freedom and control for the sender over what type of advertisement and who should receive the advertisement.

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Based on the forgoing, and for the reasons described in the Appeal Brief, it is believed that a *prima facie* case of obviousness has not been established. Reversal of all rejections is respectfully requested.

Respectfully submitted,


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